



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/824,020 | 04/13/2004 | Pavel Pogodin | N0136/PP/IF | 5918 |

41744 7590 04/27/2007
TRANSPACIFIC LAW GROUP
617 NORTH DELAWARE STREET
SAN MATEO, CA 94401

| |
|----------|
| EXAMINER |
|----------|

MERCHANT, SHAHID R

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3694

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/27/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/824,020

Applicant(s)

POGODIN ET AL.

Examiner

Shahid R. Merchant

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Priority

1. Per Preliminary Amendment filed on August 17, 2004, Examiner has given consideration to applicant's Provisional Application No. 60/462,666 filed on April 13, 2003. For examining purposes of this application, the effective filing date will be April 13, 2003.

Claim Objections

2. Claim 2 objected to because of the following informalities: the term "binary file/don't file grading" is ambiguous. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 4-8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 4-6 and 8 recite the limitation "the system" in lines 1-2. There is insufficient antecedent basis for this limitation in the claims.
6. Claim 7 recite the limitation "the system" in lines 2-4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-11 rejected under 35 U.S.C. 102(e) as being anticipated by Grainger, U.S. Patent Application Publication 2002/0161733 (see PTO-892, Ref. A).

9. As per claim 1, Grainger teaches a method a computerized method executable by a general purpose computer, programmed to perform the steps comprising:

providing a user with an electronic invention disclosure form having data fields for data entry by the user (see paragraphs 99-107 and Figures 3A-3L);

receiving the data entries from the user and, once the user has submitted a completed form, issuing a date stamp for the completed form (see paragraph 92);

sending an electronic notice to at least one pre-defined invention reviewer, and enabling the reviewer to associate a grade to the form (see paragraph 92);

enabling a pre-designated decision maker to select one action from the group comprising "abandon" and "file" (see paragraph 92).

10. As per claim 2, Grainger teaches the method of claim 1 as described above. Grainger further teaches wherein said grade comprises a binary file/don't file grading (see paragraph 92).

11. As per claim 3, Grainger teaches the method of claim 1 as described above. Grainger further teaches wherein said group further comprises "publish" and "provisional" (see paragraphs 92-93 and 131).

12. As per claim 4, Grainger teaches the method of claim 1 as described above. Grainger further teaches wherein when said decision maker selects "file", the system automatically generates an engagement letter and send the engagement letter via email to a designated counsel, together with the completed invention disclosure form and any attachments (see paragraph 92).

13. As per claim 5, Grainger teaches the method of claim 1 as described above. Grainger further teaches wherein when said decision maker selects "publish", the system automatically generates a defensive publication and uploads the publication to a designated website (see paragraph 131).

14. As per claim 6, Grainger teaches the method of claim 1 as described above. Grainger further teaches wherein when said decision maker selects "provisional", the system automatically generates a provisional application (see paragraph 92).

15. As per claim 7, Grainger teaches the method of claim 1 as described above. Grainger further teaches enabling the reviewer to request further information and wherein when said reviewer request further information, the system automatically emails a request to the user and enables the user to add new data to form, and wherein the system issues a new electronic date stamp to the new data (see paragraph 80).

16. As per claim 8, Grainger teaches the method of claim 1 as described above. Grainger further teaches wherein said form query the user to input keywords, and wherein when said decision maker selects "file", the system automatically searches a prior art database using said keywords and generates a list of related art from said database (see paragraphs 40, 43, 58, 96-98, 105 and 140).

17. As per claim 9, Grainger teaches a computerized system executable by a general purpose computer, comprising:

- a central computer executing a main program (see Figure 2, item 100 and paragraphs 26-43);

- an invention disclosure database (see Figure 2, item 106);

- a counsel database (see Figure 2, item 106); and,

a reviewer database (see Figure 2, item 106);

wherein said main program is structured to perform the steps comprising:
providing a user with an electronic invention disclosure form having data fields for data entry by the user (see paragraphs 99-107 and Figures 3A-3L);

receiving the data entries from the user and, once the user has submitted a completed form, issuing a date stamp for the completed form and storing the completed form in said inventions disclosure database (see paragraph 92);

sending an electronic notice to at least one pre-defined invention reviewer listed in said reviewer database (see paragraph 92);

wherein when said main program receives an input to file a patent application on a selected completed form, the system automatically generates an engagement letter and send the engagement letter via email to a designated counsel from said counsel database, together with the completed invention disclosure form and any attachments (see paragraph 92).

18. As per claim 10, Grainger teaches the system of claim 9 as described above. Grainger further teaches an upload mechanism, wherein when said main program receives an input to publish said completed form, said main program compiles a disclosure document and said upload section uploads said disclosure document to a publicly accessible website (see paragraphs 26-38).

Art Unit: 3694

19. As per claim 11, Grainger teaches the system of claim 9 as described above. Grainger further teaches a prior art database and, when said main program receives an input to file a patent application on a selected completed form, the system automatically searches said prior art database and generates a prior art list (see paragraphs 96-98).

Conclusion

The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

The following prior art, which is made of record but not relied upon, is considered pertinent to applicant's disclosure.

Grainger et al., U.S. Patent Application Publication 2002/0065676 (see PTO-892, Ref. B),

Grainger et al., U.S. Patent Application Publication 2002/0059076 (see PTO-892, Ref. C),

Grainger et al., U.S. Patent Application Publication 2002/0065677 (see PTO-892, Ref. D),

Grainger, Jeffry, U.S. Patent Application Publication 2002/0072920 (see PTO-892, Ref. E),

Grainger Jeffry J., U.S. Patent Application Publication 2002/0091542 (see PTO-892, Ref. F),

Grainger Jeffry J., U.S. Patent Application Publication 2002/0111824 (see PTO-892, Ref. G),

Grainger et al., U.S. Patent Application Publication 2002/0065675 (see PTO-892, Ref. H),

Hunter et al., U.S. Patent No. 6,298,327 (see PTO-892, Ref. I),

Petruzzi et al., U.S. Patent No. 6,049,811 (see PTO-892, Ref. J).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid R. Merchant whose telephone number is 571-270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammel can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRM


ELLA COLBERT
PRIMARY EXAMINER